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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,831	11/10/2005	Marc Husemann	101769-311-WCG	6112
27386 7590 02/12/2008 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
02/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,831

Applicant(s)

HUSEMANN ET AL.

Examiner

ANISH DESAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 05/03/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 05/03/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Applicant has not provided copies of the following documents: EP 0728165 and EP 0729494.

2. The information disclosure statement filed 05/03/05 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. There is no concise explanation of relevance provided for the foreign language document titled "Houben Weyl, Methoden der Organischen...60-147". This document has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Chao (US Statutory Invention Registration H0,000,509).

Chao discloses an adhesive comprising microparticles of acrylate copolymers that are formed from higher homologs of acrylates and methacrylates. Further Chao discloses that very high tack levels are achieved with composition made from isodecyl acrylate and 2-ethylhexyl acrylate where acrylic acid, isobornyl acrylate etc. are included in the starting mixture (abstract). According to Chao the monomers such as isobornyl acrylate are added in the amount of from about 1% to 20% by weight (column 2 lines 11-20). Accordingly, Chao anticipates the claimed invention.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Buccellato et al. (WO 9824978A). US 6,861,141B2 to Buccellato et al. is relied upon as an equivalent document for convenience.

Buccellato teaches a pavement making article that has an adhesive composition comprising a reaction product of acrylic acid ester of monohydric alcohol, a non-polar ethylenically unsaturated monomer, and 0-10 parts by weight of a polar ethylenically unsaturated monomer (abstract). Further Buccellato teaches that a preferred non-polar ethylenically unsaturated monomer is isobornyl acrylate (column 2 lines 1-5). According to Buccellato "Preferably the amount of acrylic acid ester is about 55-90 parts by weight...and the amount of non-polar ethylenically unsaturated monomer [e.g. isobornyl acrylate] is about 10-45 parts by weight" (column 1 lines 50-55). Accordingly, Buccellato anticipates claimed invention.

5. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. (US 5,602,221).

Bennett teaches a pressure sensitive adhesive that includes a polymerization product of (a) 27-95 parts by weight of an acrylic acid ester of a monohydric alcohol (b) 3-75 parts by weight of a non-polar ethylenically unsaturated monomer such as isobornyl acrylate (abstract and column 3 lines 42-51), and (c) 0-5 parts by weight of a polar ethylenically unsaturated monomer (abstract). As acrylic acid ester monomers, Bennett teaches isooctyl acrylate etc. monomers at column 3 lines 32-40 which read on claimed acrylic and/or methacrylic ester monomer having the claimed formula of

claim 2. Accordingly, Bennett anticipates the claimed invention.

6. Claims 1-9, 11, 12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al. (WO 95/13328).

Regarding claims 1-5, 11, and 12, Bennett teaches a pressure sensitive thermosetting adhesive that is the polymerization product of a blend that includes (a) polymerizable monomer of prepolymeric syrup comprising (i) 10-80 parts by weight of an acrylic acid ester monomer such as isooctyl acrylate (abstract and page 3 lines 24-25), (ii) 20-90 parts by weight of a non-polar ethylenically unsaturated monomer such as isobornyl acrylate (abstract and page 3 lines 24-30), and (iii) 0-5 parts by weight of a polar ethylenically unsaturated monomer [upto 30% by weight of olefinically unsaturated monomers containing functional groups] such as benzylacrylate (note Applicant discloses the same at paragraph 0017 of the PG PUB of the present application), acrylic acid etc, and (b) one or more thermosetting resins. (abstract and page 8 lines 1-13).

Regarding claims 5, 6, 13, and 16 Bennett teaches adhesive containing additives such as tackifiers, plasticizers etc. (page 11 lines 3-8). With respect to claims 7-9, Bennett teaches a

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transfer tape at page 4 lines 1-4 and at page 12 lines 12-16, and coating of the adhesive on a transparent polyester liner (a film selected from the group consisting of polyester of claim 9) at a thickness of 19 to 21 mils (483 micrometer to 533 micrometer) (page 15 lines 1-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 8, 10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. (WO 95/13328) as applied to claim 1 above.

Regarding claims 7, 8, and 16 Bennett discloses a transfer tape at page 4 lines 1-4. Bennett is silent as to teaching of a thickness of the adhesive layer as presently claimed. It would have been obvious to select a suitable thickness of the adhesive layer motivated by the desire to form an adhesive tape. As to claim 10 of a method of bonding the adhesive tape to automobile finishes, the adhesive of Bennett is useful in the assembly of industrial components such as automobile components (page 1 lines 6-12), and the adhesives are useful as semi-structural post-curable adhesive transfer tapes for oily or clean surfaces, as melt sealing tapes, and as vibration damping tapes (page 12 lines 12-15). Thus, it would have been obvious to bond the adhesive tape to the automobile finishes in the invention of Bennett because such is an intended use of the adhesive tape of Bennett.

8. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. (WO 95/13328) as applied to claims 1,5, and 14, and further in view of Buccellato et al. (WO

98/24978A). US 6,861,141B2 to Buccellato et al. is relied upon as an equivalent document for convenience.

Bennett is silent as to teaching of the amount of tackifier as claimed. However, the invention of Buccellato is previously disclosed. Buccellato further discloses that the adhesive composition of his invention includes tackifier in the amount of from about 1 to 50 parts per 100 parts acrylate containing polymer (column 2 lines 21-25). It would have been obvious to add the tackifier in the adhesive of Bennett in the amount taught by Buccellato, motivated by the desire to form an adhesive tape with suitable tackiness.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

APD

/Terrel Morris/

Terrel Morris

Supervisory Patent Examiner

Group Art Unit 1794